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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/578,942 09/07/90 CALATAYUD

J RCS-2-001

EXAMINER
GRUMBELING, M

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1100 SUPERIOR AVE., STE. 700
CLEVELAND, OH 44114-2518

ART UNIT	PAPER NUMBER
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1202

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DATE MAILED: 02/19/92

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 12/13/91 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|--|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. ✓ | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-20 are pending in the application.
Of the above, claims 4-12 are withdrawn from consideration.
2. ☒ Claims 13, 16 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-3, 14-15, 17-20 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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Applicant's election of invention I, claims 1-3 and 13-16 in Paper No. 9, filed 12/13/91 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (M.P.E.P. § 818.03(a)).

This application contains claims 4-12 drawn to an invention non-elected with traverse in Paper No. 5. A complete response to the final rejection must include cancellation of non-elected claims or other appropriate action (37 C.F.R. § 1.144) M.P.E.P. § 821.01.

Claims 1-12, 14, 15, 17-20 are in the case. Claims 13 and 16 have been canceled. Claims 17-20 have been added by amendment. Claims 4-12 have been withdrawn from consideration as being drawn to a nonelected invention.

Claims 14, 18 and 20 are rejected under 35 U.S.C. § 101 because they lack patentable utility. This rejection was first applied to claim 14 in paper 6, filed 7/9/91. Since applicant has not traversed this ground of rejection, the examiner assumes that applicant acquiesces to examiner's rejection. Claims 18 and 20 are rejected for reasons applied to claim 14 in paper 6, filed 7/9/91.

Claims 14, 18 and 20 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification in paper 6, filed 7/9/91.

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In addition, claim 20 is not supported by an adequate written description in the specification. There is no description of what is meant by 'mammalian' in the specification.

Claims 14, 15, 17, 18 and 20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 14 and 15 were rejected in paper 6, filed 7/9/91 under the same statute but applicant has not argued this ground of rejection. Applicant is assumed to have acquiesced on this rejection. Claim 18 is open ended. It is not clear to what or whom the method is applied. Claim 17 is redundant in that it is not distinct from claim 1 from which it depends. *Sakano et al. v. Rutemiller*, 158 USPQ 47. Claim 20 lacks antecedent basis in the specification because 'mammalian' are not described in the specification.

Claims 1, 14, 15 and 17-20 are rejected under 35 U.S.C. § 103 as being unpatentable over Bratsand et al. (A)

Claims 1-3, 14, 15 and 17-20 are rejected under 35 U.S.C. § 103 as being unpatentable over Bratsand et al. (A) in view of Bratsand et al. (B).

Since Applicant has not argued these rejections separately, they will be treated together. Applicant relies on the data provided in the attachment to the response to overcome the

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rejection. This is not sufficient to overcome the rejection because the data are not presented in declaration form and because it is not possible to determine from the data whether they were acquired under the same conditions because Meier is a foreign language reference which the examiner cannot comprehend. Furthermore, the data presented are not convincing in and of themselves because the therapeutic Index Systemic ED 50/ Topical ED 50 values for example 16 of Brattsand et al. and EL-854 are very similar and one of skill in the art would expect the two to have similar activities due to their similar structures. Thus the results presented are not convincing.

Arguments directed to MacDonald and Diessi are deemed moot since no rejection has been made over these references.

Applicant's attention is drawn to the PTC-1449. Certain references were not considered by the examiner. AAC and AAK are not in English and are not understandable by the examiner. AAL and AAM are not publications available to the public. References AA, AB and AC were previously cited by the examiner.

Note also that titles and dates of publications should always be provided on the 1449.

Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

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A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew V. Grumbling whose telephone number is (703) 308-4713.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

Markand J. Sheb
JAN 13 1992
SENIOR PATENT EXAMINER
GROUP 120 - ART UNIT 122

mvg

Matthew V. Grumbling
February 12, 1992